

Application No. 10/024,269  
Amendment dated May 10, 2005  
Office Action dated March 10, 2005

### **Remarks**

Applicants have amended claims 45, 46, 49, 50 and 52 and added new claims 61-64. Claims 45-52 and 58-64 remain in the application and re-examination and reconsideration of the application are respectfully requested.

Amended claim 45 and new claim 61 are directed to a slide case and apparatus, respectively, having a rack with a dual use capability of first, holding slides during a slide processing operation and second, being positionable in a base with a cover for transporting the slides. The support bars are cantilevered off respective side walls by having respective first and third longitudinal edges attached to respective side walls, thereby making opposite second longitudinal edges deflectable with respect to the walls of the rack. The second and fourth longitudinal edges of the respective first and second support bars are spaced above a lowermost portion of the rack to provide a drainage area below the support bars during a slide processing operation. The deflectable support bars function with a projection on the cover to secure the slides in the base and rack for transportation and shipping. New claim 63 is directed to a similar dual use apparatus in which the base and cover that supports the slide rack have substantially similar constructions that provide for projections on both elements.

Claims 45-52 and 58-60 are rejected under 35 U.S.C. §103(a) as being unpatentable over Watanabe (Japanese Publication No. 52-118,390) in view of Davis (U.S. Patent No. 3,960,268). Watanabe relates to an "IC wafer transporting container that is improved against contamination and damage to the wafers." Referring to Fig. 4 of Watanabe, a wafer support 3 has a connector 6 that connects to opposed support parts 7 extending from respective projections 9. Fixing parts 8 are connected to the top ends of the projections 9 and fit into respective grooves 17 on opposite sides of a box 2. The connector 6 of the wafer support 3 is attached to a bottom surface of the box 2 by means of rivets 14. A lid 1 has a wafer-top holder 4 attached to its back side. Thus, when wafers 5 are placed in openings between the projections 9 and the lid 1 is placed on the box 2, the wafer-top holder 4 pushes against the tops of the wafers 5; and the projections 9 bend slightly downward as shown in Fig. 4, thereby securing the wafers 5 in the box 2.

Application No. 10/024,269  
Amendment dated May 10, 2005  
Office Action dated March 10, 2005

Davis relates to a universal frame for securing pieces of sheet material for processing, storage and use with a carton for shipment. Referring to Fig. 1, a frame 1 is formed by racks 10 and 11 that are spaced apart on a pair of rods 13, 14 to accommodate specimen slides of different widths. The rods 13, 14 are inserted in passages 22, 23, 24, 25 of respective bosses 26, 27, 28, 29. As shown in Fig. 3, the passages have a compression ridge 32 that exerts sufficient interference with the penetrating rods to retain a rack 10 in its desired position on a rod 14, see col. 3, lines 45-51 and col. 2, lines 42-46. End pieces 18, 19 have a triangular cross section to maintain an orientation between base sides 16 and angular sides 17 of respective racks 10, 11. After slides 5 are inserted into the racks 10, 11, the racks are slid together on the rods 13, 14 to cause a slight deformation of inside surfaces of apertures 20 bearing against the slides. This slight deformation creates a retaining force to maintain the slides in firm engagement with the racks 10, 11, see col.2, lines 59-68. Thus, the slides 5 are maintained locked or secured in the frame 1 independent of frame orientation. As shown in Fig. 6, the frame 1 and slides 5 locked therein can be placed in a heat shrinkable envelop 40 for storage. The envelop 40 with frame 1 and slides 5 can also be packaged in a shipping carton for transportation purposes.

In order to establish a prima facie case of obviousness, it is necessary that the Office Action present evidence, preferably in the form of some teaching, suggestions, incentives or inference in the applied prior art or, in the form of generally available knowledge, that one having ordinary skill in the art would have been led to arrive at the claimed invention. Applicants submit that a prima facie case of obviousness is not made because Watanabe and Davis do not teach, suggest or motivate one to provide the features recited in the amended and new claims.

First, claim 45 recites a drainage area below the support bars to facilitate use of the rack in a slide processing operation.

In contrast, the Watanabe wafer transporting container is used only for transporting wafers and is not intended for use in a wafer processing operation. The wafer support 3 has opposed support parts 7 extending from projections 9, which are joined by a connector 6 that extends below the projections 9 and support parts 7

Application No. 10/024,269  
Amendment dated May 10, 2005  
Office Action dated March 10, 2005

across a bottom of the container. Thus, the space below the projections 9 and support parts 7 is not open and would not provide suitable drainage if the wafer support was used in a wafer processing operation.

Further, as described at col. 3, lines 29-39, the Davis frame has subtleties in its design that promote drainage when the frame is used in a slide processing operation. However, as described at col. 3, lines 39-44, a lower surface of the base 16 is not deemed critical in the promotion of drainage or runoff. A lower longitudinal edge of the angled side 17 is contiguous with the lower surface of the horizontal base 16 and contacts a supporting surface as does the lower surface of the base 16. Thus, by design, there is no drainage space below the angled sides 17 supporting the slides because Davis expressly deems such to be noncritical to drainage. In contrast, Applicants' claims recite drainage spaces below the support bars.

Neither Watanabe nor Davis, either alone or in combination, recite, suggest or motivate one to provide an apparatus having an open space below a slide supporting structure to promote drainage during a slide processing operation.

Second, claim 45 recites a rack having planar and parallel side walls connected to planar and parallel end walls and a base having four walls connected to a bottom. In contrast, the Watanabe wafer box 2 is intended for only transportation, and thus, there is no motivation to add structure to the wafer support 3.

The universal frame of Davis is designed to lock and retain slides in the frame independent of any other structure. Thus, after the slides are locked in the frame, the frame can be readily moved and handled without concern that the slides will fall out of the frame. The frame can be placed in a heat shrinkable envelop and thereafter, packaged in a shipping carton for transportation. The slide locking feature of the Davis frame is sufficiently strong to secure the wafers during transportation; and that ability to secure slides in the frame for handling and shipping is an important feature. Further, that locking feature requires that the racks be movable toward each other with an interference fit on the rods, so that once pushed together with the slides engaged in the apertures, the racks apply a constant force to hold the slides therebetween and do not separate.

Application No. 10/024,269  
Amendment dated May 10, 2005  
Office Action dated March 10, 2005

Therefore, there is no expression, suggestion or motivation in Davis to provide end walls to the Davis frame. Fixing the racks of Davis with end walls would not permit the racks to secure the slides in place and would permit the slides to readily fall out of the frame. Such a modification would eliminate an important feature of Davis of moving the racks on the rods to secure the slides.

Applicants submit that claims 45-52 and 58-60 are patentable and not obvious under 35 U.S.C. §103(a) over Watanabe (Japanese Publication No. 52-118,390) in view of Davis (U.S. Patent No. 3,960,268).

Applicants appreciate the opportunity for a telephone interview with the Examiner on May 5 during which amended claim 45 and the cited references were discussed. The Examiner agreed that amended claim 45 distinguishes over the combination of cited references and overcomes the rejection. However, the Examiner further indicated that the added limitation of the spacing below the support bars for drainage would require additional searching, and therefore, an issuance of Advisory Action was probable.

Applicants respectfully submit that the application is now in condition for allowance and reconsideration of the application is respectfully requested. The Examiner is invited to contact the undersigned in order to resolve any outstanding issues and expedite the allowance of this application.

Respectfully submitted,

WOOD, HERRON & EVANS, L.L.P.

BY 

C. Richard Eby, Reg. No. 25,854

2700 Carew Tower  
Cincinnati, OH 45202  
(513) 241-2324  
(513) 241-6234 (Facsimile)  
reby@whepatent.com (Email)